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Martin G. Linihan

Name

Martin G. Linihan

Signature

December 17, 2004

Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ross C. Terrell

Serial No. 10/644,500

Group Art Unit 1621

Filed: August 20, 2003

Examiner: M. Shippen

For: METHOD FOR THE PREPARATION OF SEVOFLURANE

REPLY BRIEF

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Herewith is appellant's Reply Brief in triplicate in response to the Examiner's Answer mailed October 20, 2004.

In reply to the Examiner's opinion in paragraph (5) of the Answer concerning the summary of invention, the features mentioned on pages 2 and 3 of appellant's Brief are, in fact, called for in the claims. The first paragraph of appellant's summary of the invention on page 2 of the Brief includes the subject matter of claim 4. The second paragraph thereof comprises the subject matter of claims 5, 6 and 20. The third paragraph thereof comprises the subject matter of claims 8 and 13. The fourth paragraph thereof comprises the subject matter

of claim 15. The fifth paragraph thereof comprises the subject matter of claim 23. Thus, contrary to the Examiner's characterization of the summary of the invention in appellant's Brief, five out of the six paragraphs thereof are directed to features recited in the claims. The sixth paragraph summarizes advantages and attributes of the claimed invention which appellant is entitled to have considered on the issue of patentability.

The text of paragraph (10) of the Examiner's Answer beginning at the bottom of page 3 and continuing through the first paragraph on page 6 is substantially identical to pages 2-4 of the Final Rejection. This has been fully responded to in appellant's Brief and no further comment is necessary here.

Responsive to paragraph (11) of the Examiner's Answer, the reason why USP 4,874,901 and the argument based thereon were never presented before Final Rejection is simply that they are in response to the Examiner's position in the Final Rejection and obviously could be presented only after the Final Rejection. Since the examples set forth on pages 5 and 6 of Appellant's Brief are based on examples set forth in USP 4,874,901 it is questioned why they would need to be in affidavit form.

In reply to the Examiner's presentation of two dimensional images of reactants on pages 7 and 8 of the Answer, appellant maintains the position, as set forth on page 4 of the Brief, that it is difficult to predict reactivity based on either two-dimensional or three-dimensional molecules.

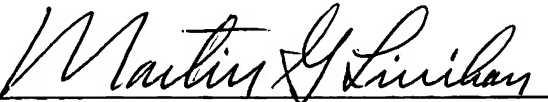
Finally, in reply to the double patenting matter, a terminal disclaimer is filed herewith to remove this as an

issue. The Examiner is requested to enter this in the application to simply the issues before the Board.

For the reasons set forth above and in appellants' Brief, the Board is respectfully requested to reverse the 35 USC 103 rejection of record and find that claims 1-13 and 18-24 define patentable subject matter over the art of record.

Respectfully submitted,

HODGSON RUSS LLP

By   
Martin G. Linihan,  
Reg. No. 24, 926

One M&T Plaza, Suite 2000  
Buffalo, New York 14203-2391  
Tel: (716) 848-1367 (direct)  
DATE: December 17, 2004